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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,439	11/26/2001	Jimmy Tsen	06128-266001	9505

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225 FRANKLIN ST
BOSTON, MA 02110

EXAMINER

PATTERSON, MARIE D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 05/15/2003 /d

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/994,439

Applicant(s)

TSEN ET AL.

Examiner

Marie Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the base panel with contours and stroebel stitching must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is no basis in the specification for a contoured base panel or stroebel stitching.

Claim Rejections - 35 USC § 112

3. Claims 5, 7, 9, 10, 15-17, 28, and 30-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 5 the phrase "configured to adopt the shape..." is confusing, vague, and indefinite because it is not clear what structural limitations applicant intends to encompass with such language.

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Claims 7 and 28 repeat a limitation present in the claims from which they depend. It is not clear what further structural limitations applicant intends to encompass with such claims.

Claims 9 and 10 and in claim 30 the phrase "base panel contoured to approximate..." are confusing, vague, and indefinite because no such base panel has been disclosed. It is not clear what structural limitations applicant intends to encompass with these claims.

In claim 15 the phrase "comprises uncured rubber", it would appear that the rubber in the finished shoe is cured, i.e. vulcanized, rendering the claim vague, indefinite, and inaccurate.

In claim 17 the phrase "said base panel" lacks antecedent basis rendering the claim vague and indefinite.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taber (3932950) in view of Giese (5572805) and Campagna (2481389).

Taber shows a shoe (figure 7) and inherent method of making said shoe comprising a molded rubber outsole (5), a molded midsole (26), an upper (22), a base panel (lower portion of 22 shown above element 26 in figure 7), an insole (24), and foxing (52)



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substantially as claimed except for the exact outsole and midsole and the method of bonding the foxing. Giese teaches forming a sole (figures 78-82) by providing an outsole (5) in a shell shape with a rim and placing the midsole (2 and 3) within the shell shaped outsole and further teaches contouring the midsole. Campagna teaches the use of uncured rubber for a foxing and teaches vulcanizing the foxing (9) to a rubber sole (7) as a method of attaching the foxing to the sole (column 4 lines 20-30).

Campagna also teaches placing foxing (9) over a seam formed by the sole (7) and the upper (1), see figure 2). It would have been obvious to provide a contoured midsole and shell shaped outsole as taught by Giese and to form a seam between the outsole and upper and vulcanize a foxing thereon as taught by Campagna in the shoe and method of Taber to increase comfort, support, stability, durability, etc..

In reference to claim 13, Taber as modified above discloses the claimed invention except for the exact material for the upper. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use canvas or PVU (it is noted that Campagna specifically teaches the use of canvas), since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

In reference to claims 14 and 20, it is extremely well known and conventional to use Stroebel stitching to secure uppers to soles. It would have been obvious to use Stroebel stitching as is well known and conventional to attach the sole to the upper in

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the shoe of Taber as modified above to make the connection more durable and stronger.

In reference to claims 18 and 31, it is well known and conventional to make insoles removable. It would have been obvious to make the insole of Taber as modified above removable so that it may be cleaned, changed, etc. Also, it is noted that the insole of Taber is considered to be "removable" inasmuch as applicant has defined and claimed such.

In reference to claims 19-26, Taber discloses the method of bonding the midsole and outsole (column 2 lines 7-13) to form a sole, attaching the upper to the sole (column 2 lines 58-68 and shown in figure 7), placing the foxing material around the upper and sole and bonding such substantially as claimed except for the exact sole configuration and the exact method of placing the foxing. Giese teaches making a sole by forming an outsole as a shell (5, shown in figures 78-82) and placing a contoured midsole (2 and 3) formed by a contoured last therein. Campagna teaches the method of attaching a shell shaped outsole (7) to an upper (1) and placing a foxing (9) over the seam and vulcanizing. It would have been obvious to form the midsole/outsole sole as taught by Giese and to attach the sole to the upper as taught by Campagna in the method of making a shoe of Taber to provide a shoe with increased comfort, stability, durability, etc..

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1. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302. (Note that the Examiner **cannot** confirm receipt of faxes) Please identify Examiner ____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted.

Inquiries only concerning the **merits** of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Marie Patterson
Primary Examiner
Art Unit 3728